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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,637	12/29/2003	Syed Rizvi	001-265	1636
29569	7590	08/15/2005	EXAMINER	
JEFFREY FURR 253 N. MAIN STREET JOHNSTOWN, OH 43031			TOY, ALEX B	
			ART UNIT	PAPER NUMBER

3739

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

7/2/05

Office Action Summary	Application No. 10/707,637	Applicant(s) RIZVI, SYED	
	Examiner Alex B. Toy	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 2 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 9 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 2. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 6 specifies "removal of the parts of the fallopian tubes in it's [sic] entirety." It is unclear how one could use the invention to remove a part of something in its entirety. By definition, a part is a fraction of something and cannot be the entirety of something. The meaning is unclear.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 2 and 9 (a duplicate of claim 2) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 9 reference claim 1, but the preambles do not match the preamble of claim 1. Therefore, it is unclear whether claims 2 and 9 are dependent or independent claims. In addition, the term "embodiment" usually denotes an entire invention and not an element of an invention. Therefore, the scope of the claim is unclear. Finally, since no structure is specified, it is unclear what is being claimed and what the applicant regards as the invention.

Claims 3-7 and 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 10 provide for the use of the laparoscopic device as claimed in claims 1 and 8, respectively, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3-7 and 10-14 are rejected under 35 U.S.C. 101 because the claimed recitation of a use in claims 3 and 10, without setting forth any steps involved in the

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process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tischer (U.S. Pat. No. 4,655,216) in view of Ryan (U.S. Pat. No. 6,152,923).

Regarding claim 1, Tischer discloses a laparoscopy instrument comprising:

a shaft 8 connecting a proximal end and a distal end (Figs. 1 and 2);

a handle 1 on said proximal end, said handle attached via plug device 7 to a power source for bipolar electrocautery (col. 1, ln. 7-9 and col. 4, ln. 25-28) with said

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handle housing embodiments 2 and 3 to engage cautery means B and cutting means F (Figs. 1 and 2);

a tip on said distal end, with said tip housing one fixed jaw A and two movable jaws B and F (col. 4, ln. 36-39), said fixed jaw A and one movable jaw B connected via conductors N and O to said power source for bipolar cautery via plug device 7 in said shaft (col. 4, ln. 28-30 and col. 4, ln. 40-41), the other movable jaw F is a cup shape cutting jaw connected to said handle via said shaft with pull rod H (col. 4, ln. 49-51). See Figs. 1 and 2. Regarding the cup shape, the cutting jaw forms a convex cup shape as seen in the side view in Fig. 2.

The claim differs from Tischer in calling for a shaft rotation means. Ryan, however, teaches a laparoscopic instrument for bipolar electrocautery and cutting comprising a shaft rotation means 24 for controlling the rotational movement of the forceps about a longitudinal axis (col. 4, ln. 45-48 and Fig. 1A). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tischer to include a shaft rotation means in view of the teachings of Ryan for controlling the rotational movement of the forceps about a longitudinal axis.

Regarding claims 2 and 9 (a duplicate of claim 2), Tischer discloses the instrument of claim 1 in view of Ryan. Tischer also teaches an ergonomically efficient embodiment that allows the surgeon to use the middle finger for an additional step during a surgical procedure without moving or repositioning the fingers. The middle finger can be used to actuate handle 3 to move cutting jaw F without moving the other

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fingers from handle 2 which controls movable jaw B for bipolar electrocautery (col. 4, In. 23-24, col. 4, In. 50-51, and Figs. 1 and 2).

Regarding claim 3, Tischer discloses the instrument of claim 1 in view of Ryan. In addition, Tischer discloses a method of using the instrument (col. 5, In. 14-43).

Regarding claim 4, Tischer discloses the method of claim 3 in view of Ryan. Tischer further discloses a method having simultaneous manipulation, cauterization, dissection, and removal of body tissue (col. 5, In. 14-43).

Regarding claim 5, Tischer discloses the method of claim 3 in view of Ryan. Tischer further discloses a method having simultaneous cauterization, dissection, and removal of the parts of the fallopian tubes (col. 1, In. 9-15 and col. 5, In. 14-43).

Regarding claim 6, Tischer discloses the method of claim 3 in view of Ryan. Tischer further discloses a method having simultaneous cauterization, dissection, and removal of the parts of the fallopian tubes in their entirety (col. 1, In. 9-15 and col. 5, In. 14-43).

Regarding claim 7, Tischer discloses the method of claim 3 in view of Ryan. Tischer further discloses a method for performing female sterilization (col. 1, In. 9-15 and col. 5, In. 14-43).

Regarding claim 8, Tischer discloses a laparoscopy instrument comprising:
a shaft 8 connecting a proximal end and a distal end (Figs. 1 and 2);
a handle 1 on said proximal end, said handle attached via plug device 7 to a power source for bipolar electrocautery (col. 1, In. 7-9 and col. 4, In. 25-28) with said handle housing embodiment 2 to engage cautery means B (Figs. 1 and 2);

a tip on said distal end, with said tip housing one fixed jaw A and two movable jaws B and F (col. 4, ln. 36-39), said fixed jaw A and one movable jaw B connected via conductors N and O to said power source for bipolar cautery via plug device 7 in said shaft (col. 4, ln. 28-30 and col. 4, ln. 40-41), the other movable jaw F is a cutting jaw connected to said handle via said shaft with pull rod H (col. 4, ln. 49-51). See Figs. 1 and 2. Regarding the cup shape, the cutting jaw forms a convex cup shape as seen in the side view in Fig. 2.

The claim differs from Tischer in calling for a shaft rotation means. Ryan, however, teaches a laparoscopic instrument for bipolar electrocautery and cutting comprising a shaft rotation means 24 for controlling the rotational movement of the forceps about a longitudinal axis (col. 4, ln. 45-48 and Fig. 1A). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tischer to include a shaft rotation means in view of the teachings of Ryan for controlling the rotational movement of the forceps about a longitudinal axis.

Regarding claim 10, Tischer discloses the instrument of claim 8 in view of Ryan. In addition, Tischer discloses a method of using the instrument (col. 5, ln. 14-43).

Regarding claim 11, Tischer discloses the method of claim 10 in view of Ryan. Tischer further discloses a method having simultaneous manipulation, cauterization, dissection, and removal of body tissue (col. 5, ln. 14-43).

Regarding claim 12, Tischer discloses the method of claim 10 in view of Ryan. Tischer further discloses a method having simultaneous cauterization, dissection, and removal of the parts of the fallopian tubes (col. 1, ln. 9-15 and col. 5, ln. 14-43).

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Regarding claim 13, Tischer discloses the method of claim 10 in view of Ryan. Tischer further discloses a method having simultaneous cauterization, dissection, and removal of the parts of the fallopian tubes in their entirety (col. 1, ln. 9-15 and col. 5, ln. 14-43).

Regarding claim 14, Tischer discloses the method of claim 10 in view of Ryan. Tischer further discloses a method for performing female sterilization (col. 1, ln. 9-15 and col. 5, ln. 14-43).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Pat. No. 5,013,312 to Parins et al.
U.S. Pat. No. 6,041,679 to Slater et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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8/9/05

Michael Peffley
MICHAEL PEFFLEY
PRIMARY EXAMINER